



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,128	01/13/2004	John William Barrs II	AUS920031019US1	3271

35525 7590 12/12/2006

IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS, TX 75380

EXAMINER

LIN, SHEW FEN

ART UNIT	PAPER NUMBER
----------	--------------

2166

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/756,128

Applicant(s)

BARRS ET AL.

Examiner

Shew-Fen Lin

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/4/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,13-16 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-10, 13-16, and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

- a. This action is taken in response to amendments and remarks filed on 10/4/2006.
- b. Claims 1-2, 5-10, 13-16, and 19-26 are pending and claims 21-26 have been added.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim(s) 15 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 15 is drawn to functional descriptive material recorded on a computer readable medium. Normally, the claim would be statutory. However, the specification, at page 17, lines 10-20 defines the claimed computer readable medium as

Art Unit: 2166

encompassing statutory media such as a “floppy disk”, “hard disk drive”, “RAM”, etc, as well as *non-statutory* subject matter such as a “radio frequency” and “light wave”.

A “light wave” embodying functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory classes of § 101. Rather, “light wave” is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as radio frequency, light wave, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

Response to Amendment and Remarks

Applicant’s remarks submitted on October 4, 2006 with respect to claims 1-2, 5-10, 13-16, and 19-20 have been fully reconsidered but are not deemed persuasive for the reasons set forth below.

Response to remarks on 35 U.S.C. § 101 rejections

First of all, the 101 Rejection is still maintained as shown above. The Applicant is once again being encouraged and advised to amend the claims so that the subject matter disclosed therein is statutory. Please refer to the 101 rejections presented earlier in this Office Action and the USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject

Art Unit: 2166

Matter Eligibility". To view the new guidelines for 35 U.S.C. 101, please view the following OG notice

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>

Response to remarks on 35 U.S.C. § 103 rejections

Applicant contends that Mayer does not teach the limitation of "the session data includes memory segments related to the session for the program and process information related to the session for the program" because Mayer teaches that "word document and properties are saved" and the document properties are merely attributes or characteristics of the document, such as title, author, type, location, size, number of pages, paragraphs, lines, words, and characters of the document and when the document was created, modified, and accessed. The Examiner respectfully disagrees with this assessment for the following reason.

First, any macro (Visual Basic code) associated with word document is saved along with the document. As in a well-known example of virus macro, which is a self-replicating program codes that are saved with document.

Second, word tracks changes to a document, such inserting text, deleting text or changing formatting, and those information are saved with the document. This provides the information to accept or reject (redo/undo) changes.

Third, when interpreted in the broadest possible way, as examiners are expected to do under MPEP guidelines, "process information" may comprise any information related to processing document/files. As such, information relates to when the document was created, modified, and accessed is processing information.

For the above reasons, therefore, Mayer teaches, "the session data includes memory segments related to the session for the program and process information related to the session for the program".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 5-10, 13-16, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham Mayor ("Automatically Backup Word Documents", 10/18/2003, http://gmayor.com/automatic_numbering_documents.htm, hereinafter referred as Mayor) in view

Art Unit: 2166

of WindowsITPro ("More on Autosave, 6/2003,

<http://www.windowsitpro.com/Windows/Article/ArticleID/38842/38842.html>).

As to claim 1, Mayor discloses a in a data processing system for saving session data (backup word documents, title), the method comprising: responsive to a closing of a session for a program (save document, page 2, paragraph 3), placing session data associated with the program in a file in a selected location to form a stored file (define backup path and file name, page 2, paragraph 5; "Sub SaveToTwoLocations"), wherein the session data includes memory segments related to the session for the program and process information related to the session for the program (both word document data and properties are saved, i.e. macro, tracking changes, page 2, paragraph 5); and associating an identification with the stored file to identify the stored file in the selected location (backup file name with path, page 2, paragraph 5, "strFileB").

Mayor discloses the elements of claim 1 as noted above but does not explicitly disclose saving data while closing a session.

WindowsITPro discloses automatically save files when closing Word (paragraph 2, lines 1-2).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Mayor's disclosure to include Autosave when closing Word as taught by WindowsITPro for the purpose of avoiding existing Word without saving the work (paragraph 1, WindowsITPro). The skilled artisan would have been motivated to improve the invention of Mayor per the above such that any modification made on document will be saved automatically on closing/ exiting from Word (paragraph 2, WindowsITPro).

As to claim 2, Mayor discloses responsive to an indication to save data generated using the program to a permanent storage (“save” function to save document, paragraph 7), placing current session data associated with the program in another file in the selected location to form another stored file (save to two locations, page 2, paragraph 3-5); and associating another identification to identify the another stored file in the selected location (backup file name with path, page 2, “strFileB).

As to claim 5, Mayor discloses responsive to a selection of the identification of the stored file in the selected location, restoring the session using the stored file (similar to autorecover for word file, select any backup file to restore, page 1, paragraph 2).

As to claim 6, Mayor discloses the method of claim 5, wherein the restoring step includes: initiating execution of the program using the session data in the stored file (word document properties is saved with the document, select the document will initiate the program and document, page 1, paragraph 2).

As to claim 7, Mayor discloses wherein the selected location is a location used to hold deleted files in a manner that allows for recovery of the deleted files at a later time (backup directory can be specified in the way that can be used for recovery of the deleted files, page 3, paragraph 1).

As to claim 8, refer to “As to claim 1” presented earlier in this Office Action. Further, Mayor teaches processing unit with memory (disk, page 3, paragraph 1), communication unit (display, pages 1-3) that executes the set of instructions (page 2) as described in claim 1.

As to claim 9, refer to “As to claim 1” presented earlier in this Office Action.

As to claim 10, refer to “As to claim 2” presented earlier in this Office Action.

As to claim 13, refer to “As to claim 5” presented earlier in this Office Action.

As to claim 14, refer to “As to claim 6” presented earlier in this Office Action.

As to claim 15, refer to “As to claim 1” presented earlier in this Office Action.

As to claim 16, refer to “As to claim 2” presented earlier in this Office Action.

As to claim 19, refer to “As to claim 5” presented earlier in this Office Action.

As to claim 20, refer to “As to claim 6” presented earlier in this Office Action.

Claims 21, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayor and WindowsITPro as applied to claim 1 above, and further in view of Chaurasia (US Patent Publication 2005/0050389).

As to claim 21, Mayor and WindowsITPro disclose the elements of claim 1 (data segment includes current document, changes information) as noted above but does not explicitly disclose wherein the code segments include code used to execute the program so that if the program were deleted from the data processing system a user is still able to view and edit the stored file, and wherein the data segment includes clipboard information of the session.

Art Unit: 2166

Chaurasia discloses generating core dump file for software application and then run on a different platform other than a source platform (i.e. still able to view and edit the stores file without original program) (abstract, paragraph [0001], [0007]) and the core dump file including data relating to the process, data segments, stack segments, shared memory segments (i.e. clipboard information), and MMAP memory segment to the core file (paragraph [0016]).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Mayor and WindowsITPro's disclosure to include memory segment and data segment required to run the software as taught by Chaurasia for the purpose of viewing/editing files when the source platform is not available (paragraph [0001], Chaurasia). The skilled artisan would have been motivated to improve the invention of Mayor and WindowsITPro per the above such that files are portable to different computer system.

As to claim 23, refer to "As to claim 21" presented earlier in this Office Action.

As to claim 25, refer to "As to claim 21" presented earlier in this Office Action.

Claims 22, 14, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayor and WindowsITPro as applied to claim 1 above, and further in view of Brodeur et al. (US Patent Publication 2002/0087950, hereinafter referred as Brodeur).

As to claim 22, Mayor and WindowsITPro disclose the elements of claim 1 as noted above but does not explicitly disclose wherein the process information is all information needed

Art Unit: 2166

to recreate the environment for the session that includes register states in a processor and an identification of threads used to run the program.

Brodeur discloses capturing snapshots of a session including threads, program data, register values, storage contents, call stack entries, etc. needed for later usage (Figure 4, paragraph [0011], [0045]).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Mayor and WindowsITPro's disclosure to include register states in a processor and an identification of threads used to run the program in the saved file as taught by Brodeur for the purpose of debugging codes to ensure that it operates properly (paragraph [0002], Brodeur). The skilled artisan would have been motivated to improve the invention of Mayor and WindowsITPro per the above such that information needed to recreate the environment for the session is saved with the file (paragraph [0003], Brodeur).

As to claim 24, refer to "As to claim 22" presented earlier in this Office Action.

As to claim 26, refer to "As to claim 22" presented earlier in this Office Action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2166

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Shew-Fen Lin
Patent Examiner

Art Unit 2166
December 10, 2006



**MOHAMMAD ALI
PRIMARY EXAMINER**